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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,408	11/19/2003	Mark Meister	3222.1320001	5313
26111 7590 10/06/2009 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
LIM, KRISNA				
ART UNIT		PAPER NUMBER		
2453				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,408

Applicant(s)

MEISTER ET AL

Examiner

Krisna Lim

Art Unit

2453

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 23-27 and 29-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 23-27, 29-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Claims 1-13, 23-27, 29-53 are still pending for examination, and claims 14-22 and 28 canceled. After further reconsideration of the last office action mailed on 8/19/2009, the rejection of the last Office action is withdrawn and the new office action is now issued.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-13, 23-27, 29-53 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Fischer [U.S. Patent No. 5,311,591].

Fischer discloses (e.g., see Fig. 3) the invention substantially as claimed. Taking claims 1, 6, 7, 8, 9, 10, 11, 12, 13, 23, 26, 27, 29, 46, 51 as exemplary claims, the reference discloses an e-mail method, comprising the steps of:

a) recognizing that an unauthorized electronic mail message is about to be sent from a computer device configured to send an electronic mail message (e.g., see col. 3 (lines 12-59), col. 4 (lines 61-68), col. 19 (lines 20-48));

b) providing at the computer device an alerting indicating that the unauthorized electronic mail message about to be sent (e.g., see col. 3 (lines 12-59), col. 4 (lines 61-68), col. 19 (lines 20-48)).

As to claim 2, Fischer discloses that an authorized electronic mail message is about to be sent comprising detecting that a send function has been initiated by an authorized agent (e.g., see col. 3 (lines 12-59), col. 4 (lines 61-68), col. 19 (lines 20-48)).

As to claim 3, Fischer discloses the authorized agent is virus (e.g., see col. 3 (lines 12-59), col. 4 (lines 61-68), and col. 9 (lines 20-48)).

As to claims 4, 47 and 49, Fischer discloses stopping transmission of the authorized electronic mail message (e.g., see col. 3 (lines 12-59), col. 4 (lines 61-68), and col. 19 (lines 20-48)).

As to claims 5, 48, 50 and 53, Fischer discloses deleting the authorized electronic mail prior to transmission of the unauthorized electronic mail message (e.g., see col. 3 (lines 12-59), col. 4 (lines 61-68), col. 19 (lines 20-48)).

As to claim 8, Fischer discloses displaying the unauthorized electronic mail message in an interface configured to input an instruction to modify the unauthorized electronic mail message, cancel transmission of the unauthorized electronic mail message (e.g., see col. 3 (lines 12-59), col. 4 (lines 61-68), col. 19 (lines 20-48)).

As to claims 30, 32, 34, 36, 38, 40 and 41, Fischer discloses the unauthorized electronic mail is composed by a virus and has a valid recipient address (e.g., see col. 3 (lines 12-59), col. 4 (lines 61-68), col. 19 (lines 20-48)).

As to claims 31, 33, 35, 37, 39, 42, 43, 44 and 45, Fischer discloses recognizing that an unauthorized electronic mail message is about to be sent including that a send operation has been initiated (e.g., see col. 3 (lines 12-59), col. 4 (lines 61-68), col. 19 (lines 20-48)).

Fischer discloses a computer system security method and system having a Program Authorization Information (PAI). PAI defines the range of operations that a program may execute and/or defines those operations that a program can not perform. The program is permitted to access what has been authorized and nothing else. When the program is to perform a function ..., the associated PAI is monitored to confirm that the operation is within the defined program limits. If the program attempts to do anything outside the authorized limits, the program execution is halted (i.e. see col. 2, lines 22-48). Fischer's system protects a user from any program to be executed. More importantly, Fischer discloses his invention served to bind limitation to programs so that it becomes impossible for covert programs or virus to be introduced into the system. Users are protected through specifying details as to the functions that may be performed to ensure that programs which are intended for one function do not accidentally or intentionally cross-over and effect other unrelated or critical resources (so as to effect the spread of computer virus) ... it is possible for users to protect themselves against the program they execute (i.e. see col. 3, lines 9-32).

Furthermore, Fischer discloses administrative agents who can effectively limit the scope of program ... to reduce the danger of program detects ... the danger of the distraught or mischievous programmer who might try to plant a software "time bomb" or virus can be limited (i.e. col. 3, lines 33-45). And, Fischer further discloses some useful

functions to be controlled to include: the ability to transmit data via electronic mail to someone outside the user's domain; the ability of a program to create or solicit digital signatures; the ability to limit access to a program of certain security classes, etc. (i.e. see col. 3, lines 51-59); the ability to make the user aware of the data to which the signature is being applied (i.e., col. 3, lines 65-66); the capability of generating a message ... and transmitting the message to any of the other terminals with signature verification on each message (i.e., see col. 4, lines 61-68).

Specifically, Fischer discloses: if an attempt is made to use electronic mail, a check is made of the PAI to determine whether the program is authorized to perform electronic mail functions and if so whether the mailing is limited to a set of mail identifiers; if the check reveals that the PAI does not allow the attempt function, then an error message is generated to indicate that the program is attempting to exceed its limits ... function is denied and an appropriate error code or message is generated (i.e., see col. 19, lines 14-48).

While Fischer clearly discloses the gist of the invention as described above, Fischer might not mention exactly as claimed. For example, Fisher might not exactly mention "an alert indicating that the unauthorized electronic mail message is about to be sent". Instead, Fisher mentions an error code or a message is generated to indicate that the electronic mail function is denied. Clearly Fischer discloses PAI is checked to make sure that it is authorized to perform electronic mail function and to ensure that the programs do not defected with virus. Thus, it would have been obvious to one of ordinary skill in the art to recognize that the teaching of Fischer is the same as claimed language because Fisher clearly discloses the error message (alert) is generated when the electronic mail function is denied (unauthorized function).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13, 23-27 and 29-53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No.

6,671,718. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to email method and system having the steps of: recognizing an unauthorized email message (email with an unintended recipient address); alerting indication message.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

If NO period for reply is specified above, the maximum statutory period will apply

and will expire SIX (6) MONTHS from the mailing date of this communication.

Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne, can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

September 30, 2009

/Krisna Lim/

Primary Examiner, Art Unit 2453